

REMARKS

Claims 1 through 5 are pending in the Office Action. The Office Action provisionally rejected claims 1-5 under the judicially created doctrine of obviousness-type double patenting. The Office Action also rejected claims 1-3 and 5 as being anticipated and claim 4 as being obvious over the prior art. Applicant has amended claim 1 to further clarify the invention as recited therein. Applicant respectfully submits that the amendments to claim 1 do not add new matter and requests entry thereof. Applicant respectfully requests reconsideration of claims 1 through 5 in view of the following remarks.

Please note that Applicant's remarks are presented in the order in which the issues were raised in the Office Action for the convenience and reference of the Examiner. In addition, Applicant requests that the Examiner carefully review each of the references discussed below to ensure that Applicant's understanding and discussion of the references is consistent with the Examiner. Further, the following remarks are not intended to be an exhaustive enumeration of the distinctions between any particular reference and the claimed design. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed design and that reference.

A. Double Patenting Rejection

The Office Action stated that claim 1-5 were rejected under the judicially created doctrine of obviousness-type double patenting of claims 7-11 in United States Patent Application No. 10/786,672, filed Feb. 25, 2004 (hereinafter the '672 application). Although the Office Action admits that the claims are not identical, the Office Action asserted that the claims are not patentably distinct from each other because the only difference is that the present claims disclose

the intermediate portion having indicia disposed thereon specific to marketing the device. The Office Action contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide indicia of any required kind on the intermediate portion, since it would only depend on the intended use of the assembly and the desired information to be displayed.

Further, the Office Action asserted that it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. That fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of label does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability. The Office Action concluded that claims 1-5 were provisionally rejected on the ground of double patenting of the obviousness type.

Applicant respectfully traverses this rejection. However, as stated in the Office Action, a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321 (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.130(b).

In order to expedite receiving a Notice of Allowance, Applicant submits herewith a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). Applicant is the owner of the entire interest in the present application because the Applicant is the sole inventor of the above-identified patent application and has not assigned any interest to any other person or entity.

Applicant is the owner of the entire interest in '672 application upon which the double patenting rejection is based because the Applicant is the sole inventor of the '672 application and has not assigned any interest to any other person or entity. Consequently, in view of the timely filed terminal disclaimer Applicant requests that this double patenting rejection be withdrawn.

B. Section 102 Rejection

Paragraphs 2 and 3 of the Office Action rejected claims 1-3 and 5 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,894,923 to Hamstra et al. (hereinafter *Hamstra*). *Hamstra* discloses a package or set of labels consisting of any desired number of panels of labels. Each panel consists of a label stock which may be configured into one or more labels which can be peeled away from the panel. Each panel also includes backing paper onto which is adhered the label stock. The backing paper has a plurality of folding means (e.g., perforations) to allow the label to be folded (e.g., accorded) in a compact package. The package includes means for supporting the package from a support structure. For example, a hole may be formed in each panel which holes align when the package is compressed so that the package can be suspended from a prong on a peg board. The package also includes securement means (e.g., a staple) that holds the panels together as a group. After the panels are formed and folded along the folding means, the panel is stapled and packed in a shipping container. Upon reaching a retail outlet, the packages are threaded onto a prong or other supporting structure.

As such, the *Hamstra* reference is directed toward a “compact, structurally self-supporting structure.” *Hamstra*, col. 4, ll. 24-26.

[The] label sheets being . . . securable to one another by any common securement means, such as a staple, said set not requiring any space beyond the dimensions of the set of label sheets. Further, no additional packaging components are required since the inherent rigidity of the set of label sheets provides all the structural

integrity needed to handle, ship, assemble and display the set of label sheets as a package right up to the moment of purchase in a retail outlet.

Hamstra, col. 2, ll. 46-54 (emphasis added). The *Hamstra* reference thus teaches a packet of labels which is easily hung from a display and then easily removed therefrom. As such, the *Hamstra* reference does not teach that any portion of the package is attached to a device.

However, independent claim 1 recites “A label for use with marketing a device comprising a first end; a second end; and an intermediate portion . . . wherein at least a portion of the label is adapted to be connected to the device.” Because the *Hamstra* reference does not teach that any part of the label is adapted to be connected to a device, the limitations of claim 1 are not anticipated by *Hamstra*. Nor would such a modification be obvious in view of *Hamstra* because such modification would destroy the intended function of the label package which is to provide a unitary package which is easily hung from a display and removed therefrom. Therefore, Applicant respectfully requests that the anticipation rejection with respect to claim 1 be withdrawn.

Claims 2-3 and 5 depend from independent claim 1 and thus incorporate the limitations thereof. As such, Applicant respectfully requests that the anticipation rejection with respect to claims 2-3 and 5 be withdrawn.

C. Section 103 Rejection

Paragraphs 4 and 5 rejected claim 4 as obvious under 35 U.S.C. 103(a) in view of *Hamstra*. The Office Action asserted that an intermediate portion comprising an S-shaped portion would have been an obvious matter of design choice. However, Applicant respectfully asserts that even if the label package taught by *Hamstra* were modified to have an S-shaped intermediate portion, *Hamstra* still does not teach “A label for use with a device comprising a

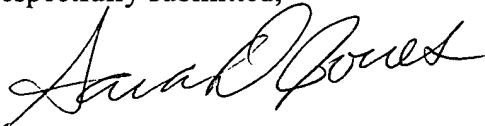
first end; a second end; and an intermediate portion . . . wherein at least a portion of the label is adapted to be connected to the device.” As such, Applicant respectfully requests that the obviousness rejection with respect to claim 4 be withdrawn.

D. Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1-5 are in condition for allowance and favorable action is respectfully requested. In the event of any question, the Examiner is respectfully requested to initiate a telephone conversation with the undersigned.

Dated this 17th day of September 2004.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Sara D. Jones", written in a cursive style.


Sara D. Jones
Attorney for Applicant
Registration No. 47,691
Customer No. 022913

SDJ:
W:\15272\35.1\SDJ0000000454V001.doc

Dated this _____ day of September, 2004.

Respectfully submitted,

WORKMAN NYDEGGER

By: 
Sara D. Jones
Registration No. 47,691
Customer Number 022913
E-mail: sjones@wnlaw.com

W:\15272\35.1\SDJ0000000457V001.doc